

REMARKS

Favorable reconsideration of this application as presently amended is respectfully requested. Claims 1-13, 15-18, 26-28, 42-44, 52, and 53 are pending. In this Amendment, claim 16 is amended. No new matter is added.

The Examiner is thanked for indicating that claim 16 would be allowable if rewritten in independent form to include all of the limitations of the base claim (claim 15). Claim 16 has been so amended in the present Amendment, and, therefore, is in condition for allowance. Because claim 17 is dependent on allowable claim 16, claim 17 is also in condition for allowance.

Applicant thanks the Examiner for the courtesies extended to Applicant's representative during an August 15, 2005 telephone interview (Examiner Interview) in which the outstanding rejections were discussed. Applicant's separate record of the substance of the interview is contained in the comments below.

A. Response to rejection of claims 1-13, 15, 17, 18, 26-28, 42-44, 52, and 53 under 35 U.S.C. § 103(a) as being as being unpatentable based on Harrington in view of Herz.

At Section 3 of the Office Action, claims 1-13, 15, 17, 18, 26-28, 42-44, 52, and 53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,895,454 to Harrington (Harrington) in view of U.S. Patent No. 6,571,454 to Herz et al. (Herz). This rejection is respectfully traversed with respect to the claims as currently presented.

1. Rejection of claims 1-13, 15, 17, 18, 26-28, 42-44, 52, and 53 based on Harrington in view of Herz is *prima facie* improper due to lack of motivation.

a. Failure of Office Action to provide proper motivation

As discussed with the Examiner during the Examiner Interview, this rejection is *prima facie* improper because it provides no appropriate basis for combining Herz with Harrington. As set forth in the Manual of Patent Examining Procedure (MPEP) at § 706.02(j), “To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, *either in the references themselves or in the knowledge generally available to one of ordinary skill in the art*, to modify the reference or to combine reference teachings (emphasis added) . . . *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure* (emphasis added). *In re Vaeck*, 947 F.2d. 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

The Office Action attempts to justify combining Herz with Harrington based on the following conclusory statement:

Therefore, it would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to have modified Harrington’s system for identifying appropriated websites which meet the user’s specific criteria about the product provided thereof would have incorporated the teachings of Herz for utilizing location-enhanced product finder; the motivation being to expand and enhance the versatility of Harrington’s system is to locate the local stores within a radius which most closely match the interest criteria to optimize search operation of finding objects containing the data of interest. (See Office Action, p. 3)

The above quoted conclusory statement fails to properly identify any text in Harrington, Herz or any other reference that would provide any motivation for combining Herz with Harrington. As stated by the Federal Circuit in *Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000), “[d]etermining whether there is a suggestion or motivation to modify a prior art reference is one aspect of determining the scope and content of the prior art, a fact question subsidiary to the ultimate conclusion of obviousness.” (citing *Tec Air, Inc. v. Denso Mfg.*, 52 USPQ2d 1296, 1297-98 (Fed. Cir. 1999) (stating that the factual underpinnings of obviousness include whether a reference provides a motivation to combine its teachings with another)). Furthermore, as noted by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references. (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the

claimed invention, would have selected these components for combination in the manner claimed.”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.”)).

For the above reasons, the rejection of claims 1-13, 15, 17, 18, 26-28, 42-44, 52, and 53 based on Harrington in view of Herz is *prima facie* improper and should be withdrawn.

b. Failure of Examiner during Examiner Interview to provide proper motivation for combining Herz with Harrington.

The Examiner was also unable to show proper motivation for combining Herz with Harrington during the Examiner Interview. During the Examiner Interview, the Examiner stated that there is motivation to combine Herz with Harrington, for the following reasons:

Harrington, col. 5, lines 53-61, suggests that database can provide maps and other information with the user might need to locate the service, or find the vendor physically) and Herz compensates Harrington’s deficiency by determining the number of location within a given threshold distance (e.g., within 10 miles radius which most closely match the interest criteria (see Herz, col. 17, lines 25-65). (See Examiner Interview Summary Record, p. 3).

However, the Examiner has not shown why a person of ordinary skill in the art reading Harrington would be motivated to look for Herz. The Examiner just states that Harrington suggests providing maps or other information to locate a service to be provided to the user or to find the vendor physically, and leaves it to the Applicant’s imagination as to why this statement would motivate a person of ordinary skill in the art to look at Herz. For example, the cited section of Harrington describes aiding a user by providing to a user “maps and other information which the [single] user might need to locate the [single] service [provider] or find the [single] vendor physically” for a service or product, respectively. In contrast, the cited section of Herz describes a system in which an advertisement is displayed “to the [multiple] users that are most likely to be interested in [a given] advertisement” (see col. 17, lines 34-41). The Examiner does not explain why a person of ordinary skill in the art would reading the section of Harrington, which relates to a *single*

user finding a *single vendor* or *service provider* for a *product* or *service*, respectively, would be motivated to read Herz which describes *advertisements* for *multiple users* for *multiple vendors*. Based on the statements by the Examiner in the Office Action and during the Examiner Interview, the motivation for combining Herz with Harrington is not found in the cited references, but is instead based on an impermissible hindsight use of Applicant's own application. The Federal Circuit has stated in *Cardiac Pacemakers Inc. v. St Jude Medical Inc.* 72 USPQ2d 1333, 1336 (Fed. Cir 2004) that "Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. See also *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1578-79 [42 USPQ2d 1378] (Fed. Cir. 1997) ("However, the record must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination."). Because the Examiner has failed to show where motivation is found in the cited references, it can only be assumed that the Examiner is relying on an impermissible hindsight use of Applicant's own application.

Therefore, for these additional reasons, the rejection of claims 1-13, 15, 17, 18, 26-28, 42-44, 52, and 53 based on Harrington in view of Herz is *prima facie* improper and should be withdrawn.

2. Rejection of claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 26, and 52 based on Harrington in view of Herz is *prima facie* improper due to failure of Office Action to identify where all claim limitations are taught or suggested.

a. Rejection of claim 1 *prima facie* improper due to failure of Office Action to identify where all the claim limitations are taught or suggested.

The rejection of claim 1 based on Harrington in view is *prima facie* improper for additional reasons. As set forth in MPEP § 706.02(j), "To establish a *prima facie* case of obviousness . . . The prior art reference (or references) when combined must teach or suggest *all of the claim limitations* (emphasis added). However, the Office Action has

failed to identify any portion of Harrington, Herz or any other reference that teaches or suggests claim 1's feature of a "search result relating to those of said records including *products* meeting said *product* identification fields and *available within a boundary* determined by [a] distance value of [a] preferred geographical location." The Office Action doesn't even mention anything about claim 1's "boundary" determined by a distance value of a preferred geographical location. Nor does the Office Action make any reference to a *product* "available within a boundary determined" by a distance value as claimed by claim 1.

b. During the Examiner Interview, the Examiner did not remedy the failure of Office Action to identify where all the claim limitations are taught or suggested.

During the Examiner Interview, the Examiner did not remedy the failure of the Office Action to identify where all the claim limitations are taught or suggested. During the Examiner Interview, the Examiner alleged:

. . . . Herz compensates [for Harrington's] deficiency by determining the number of location within a given threshold distance (e.g. within 10 miles radius which most closely match the interest criteria (see Herz, col. 17, lines 25-65). Examiner also believes that the features of determining the number of location within a given threshold distance (e.g., within 10 miles radius which most closely match the interest criteria taught by Herz are "distance" value and "preferred geographic location. (See Examiner Interview Summary Record, p. 3)

Nowhere in the above-quoted section of the Examiner Interview Summary Record does the Examiner state where Harrington or Herz teach or suggest Examiner claim 1's feature of search result relating to a product "available within a boundary determined" by a distance value as claimed by claim 1.

Therefore, for this additional reason, the rejection of claim 1 based on Harrington in view of Herz is *prima facie* improper and should be withdrawn.

c. Rejection of claims 2, 3, 4, 5, 6, 7, 8, 9, 26, and 52 is *prima facie* improper due to failure of Office Action to identify where all claim limitations are taught or suggested.

Claims 2, 3, 4, 5, 6, 7, 8, 9, 26, and 52 are dependent on claim 1, either directly or indirectly, and, thus, include at least all of the patentable features of claim 1. Therefore, the combination of Herz with Harrington does not teach or suggest all of the claim limitations of claims 2, 3, 4, 5, 6, 7, 8, 9, 26, and 52 for the reasons discussed above with respect to claim 1.

Therefore, for this additional reason, the rejection of claims 2, 3, 4, 5, 6, 7, 8, 9, 26, and 52 based on Harrington in view of Herz is *prima facie* improper and should be withdrawn.

3. Rejection of claims 10-13, 15, 18, 26-28, and 30 based on Harrington in view of Herz is *prima facie* improper due to failure of Office Action to identify where all claim limitations are taught or suggested.

The rejection of claims 10-13, 15, 18, 26-28, and 30 based on Harrington in view of Herz is *prima facie* improper for additional reasons. As set forth in MPEP § 706.02(j), “To establish a *prima facie* case of obviousness . . . The prior art reference (or references) when combined must teach or suggest ***all of the claim limitations*** (emphasis added). However, the only grounds set forth in the Office Action for rejecting claims 10-13, 15, 18, 26-28, and 30 is the following conclusory statement:

As to claims 10-13, 15, 18, 26-28, 30, all limitations of these claims have been addresses in the analysis above, and these claims are rejected on that basis. (See Office Action, p. 5)

The above statement fails to identify any features of claims 10-13, 15, 18, 26-28, and 30 that are taught or suggested by Harrington and Herz, either alone or in combination. Effectively, the Office Action leaves it to the Applicant to speculate as to the reasons why claims 10-13, 15, 18, 26-28, and 30 are rejected.

The rejection of claims 10-13, 15, 18, 26-28 and 30 also fails to comply with the requirements of 37 C.F.R. § 1.104(c)(2):

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a

reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Contrary to the requirements of 37 C.F.R. § 1.104(c)(2), no attempt has been made in the Office Action to identify any part of any reference that has been relied upon in rejecting claims 10-13, 15, 18, 26-28, and 30.

In addition, the statement in the Office Action quoted above is factually erroneous. For example, claim 10 includes the feature of a “memory means”, limitation that cannot have been addressed with respect to the analysis of claims 1-9, because none of these claims claim the feature of a “memory means”.

For at least the above reasons, the rejection of claims 10-13, 15, 18, 26-28, and 30 based on Harrington in view of Herz is *prima facie* improper and should be withdrawn.

4. Rejection of claim 17 is *prima facie* improper, because claim 17 is dependent on allowable claim 16.

The rejection of claim 17 is dependant on claim 16, and, thus, includes at least all of the patentable features of claim 16. Accordingly, claim 17 must be allowable for at least the reasons that claim 16 is allowable. Therefore, the rejection of claim 17 based on Harrington in view of Herz is *prima facie* improper and should be withdrawn.

5. Rejection of claim 42 based on Harrington in view of Herz is *prima facie* improper due to failure of Office Action to identify where all claim limitations are taught or suggested.

The rejection of claim 42 based on Harrington in view is *prima facie* improper for additional reasons. As set forth in MPEP § 706.02(j), “To establish a *prima facie* case of obviousness . . . The prior art reference (or references) when combined must teach or suggest ***all of the claim limitations*** (emphasis added). However, the only grounds set forth in the Office Action for rejecting claim 42 are the following conclusory statements:

As to claim 42, Harrington and Herz teach the invention substantially as claimed. Harrington further teaches that a wireless communication path for communicating said input query information or said input data between said input means and said searching means via said adjustment means [fig. 2] (see Office Action, p. 6).

The above statements fails to identify which elements in Harrington and Herz, either alone or in combination, are considered equivalent to the features of claim 42. Effectively, the Office Action leaves it to the Applicant to speculate as to what elements of Harrington and Herz are equivalent to the features of claim 42.

The rejection of claim 42 also fails to comply with the requirements of 37 C.F.R. § 1.104(c)(2) (quoted above). The Office Action only states that Fig. 2 shows various elements but does not identify which elements in Fig. 2 correspond to features of claim 42.

For at least the above reasons, the rejection of 42 based on Harrington in view of Herz is *prima facie* improper and should be withdrawn.

6. Rejections of claim 43 and 44 based on Harrington in view of Herz is *prima facie* improper.

a. Claims 43 and 44 are patentable over the combination of Herz with Harrington for at least the reasons discussed above with respect to claim 42.

Claim 43 is dependent on claim 42, and, thus, includes all of the patentable features of claim 42. Therefore, claim 43 is patentable over the combination of Herz with Harrington for at least the reasons discussed above with respect to claim 42.

Claim 44 is dependent on claims 42 and 43, and, thus, includes all of the patentable features of claims 42 and 43, respectively. Therefore, claim 44 is patentable over the combination of Herz with Harrington for at least the reasons discussed above with respect to claims 42 and 43.

b. Rejection of claim 43 based on Harrington in view of Herz is *prima facie* improper due to failure of Office Action to identify where all claim limitations are taught or suggested.

The rejection of claim 43 based on Harrington in view is *prima facie* improper for additional reasons. As set forth in MPEP § 706.02(j), “To establish a *prima facie* case of obviousness . . . The prior art reference (or references) when combined must teach or suggest ***all of the claim limitations*** (emphasis added). However, the only grounds set forth in the Office Action for rejecting claim 43 are the following conclusory statements:

As to claim 43, Harrington and Herz teach the invention substantially as claimed. Herz further teaches that said wireless communication path includes the use of SMS protocol [col. 3, [line] 48 to col. 4, [line] 5]. (see Office Action, p. 6).

The above statements fails to identify which elements in Harrington and Herz, either alone or in combination, are considered equivalent to the features of claim 43. Effectively, the Office Action leaves it to the Applicant to speculate as to what elements of Harrington and Herz are equivalent to the features of claim 43.

The rejection of claim 43 also fails to comply with the requirements of 37 C.F.R. § 1.104(c)(2) (quoted above). The term “SMS protocol” does not appear in the section of Herz cited in the Office Action, and the Office Action does not identify which element in the cited section is alleged to be equivalent to the “SMS protocol” of claim 43.

For at least the above reasons, the rejection of 43 based on Harrington in view of Herz is *prima facie* improper and should be withdrawn.

c. Rejection of claim 44 based on Harrington in view of Herz is *prima facie* improper due to failure of Office Action to identify where all claim limitations are taught or suggested.

The rejection of claim 44 based on Harrington in view is *prima facie* improper for additional reasons. As set forth in MPEP § 706.02(j), “To establish a *prima facie* case of obviousness . . . The prior art reference (or references) when combined must teach or suggest ***all of the claim limitations*** (emphasis added). However, the only grounds set forth in the Office Action for rejecting claim 44 are the following conclusory statements:

As to claim 44, Harrington and Herz teach the invention substantially as claimed. Herz further teaches said context information is selected from the group consisting of geographical data, user telephone number and time of day [col. 3, [line] 48 to col. 4, [line] 5].. (see Office Action, p. 6).

The above statements fails to identify which elements in Harrington and Herz, either alone or in combination, are considered equivalent to the features of claim 44. Effectively, the Office Action leaves it to the Applicant to speculate as to what elements of Harrington and Herz are equivalent to the features of claim 44.

The rejection of claim 44 also fails to comply with the requirements of 37 C.F.R. § 1.104(c)(2) (quoted above). The terms “geographical location data”, “user telephone number” and “time of day” do not appear in the section of Herz cited in the Office Action, and the Office Action does not identify which elements in the cited section are alleged to be equivalent to the features “geographical location data”, “user telephone number” and “time of day” of claim 44.

For at least the above reasons, the rejection of 44 based on Harrington in view of Herz is *prima facie* improper and should be withdrawn.

7. Rejection of claim 53 based on Harrington in view of Herz is *prima facie* improper due to failure of Office Action to identify where all claim limitations are taught or suggested.

The rejection of claim 53 based on Harrington in view is *prima facie* improper for additional reasons. As set forth in MPEP § 706.02(j), “To establish a *prima facie* case of obviousness . . . The prior art reference (or references) when combined must teach or suggest ***all of the claim limitations*** (emphasis added). However, the only grounds set forth in the Office Action for rejecting claim 53 is the following conclusory statement:

As to claims 53, all limitations of these claims have been addresses in the analysis above, and these claims are rejected on that basis. (See Office Action, p. 6)

The above statement fails to identify any features of 53 that are taught or suggested by Harrington and Herz, either alone or in combination. Effectively, the Office Action leaves it to the Applicant to speculate as to the reason why claim 53 is rejected.

The rejection of claims 53 also fails to comply with the requirements of 37 C.F.R. § 1.104(c)(2) (quoted above). Contrary to the requirements of 37 C.F.R. § 1.104(c)(2), no attempt has been made in the Office Action to identify any part of any reference that has been relied upon in rejecting claim 53.

For at least the above reasons, the rejection of claim 53 based on Harrington in view of Herz is *prima facie* improper and should be withdrawn.

B. Claims 1-13, 15-18, 26-28, 42-44, 52, and 53 have been rejected based on facts within the personal knowledge of the Examiner.

In addition, with respect to claims 1-13, 15-18, 26-28, 42-44, 52, and 53, these claims have been rejected on the basis of facts within the personal knowledge of the Examiner.

1. Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 26, and 52.

As discussed above, nowhere in the Office Action or in Examiner Interview Summary Record does the Examiner identify an element or elements in Harrington, Herz or any other reference, that corresponds to the feature of a search result relating to a product available within a boundary determined by a distance value as claimed by claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 26 and 52. Therefore, the Examiner has rejected these claims based on facts in the Examiner's own personal knowledge.

2. Claims 10-13, 15, 18, 26-28, and 30.

As discussed above, the Examiner has failed to identify any features of claims 10-13, 15, 18, 26-28, and 30 that are taught or suggested by Harrington and Herz, either alone or in combination. Effectively, the Examiner has left it to the Applicant to speculate as to the reason why claims 10-13, 15, 18, 26-28, and 30 are rejected. Therefore, the Examiner has rejected these claims based on facts within the personal knowledge of the Examiner.

3. Claim 42, 43, and 44.

As discussed above, the Examiner has failed to identify which elements in Harrington and Herz, either alone or in combination, are considered equivalent to the features of claims 42, 43 and 44. Effectively, the Examiner has left it to the Applicant to speculate as to what elements of Harrington and Herz, either alone or in combination, are equivalent to the features of claims 42, 43 and 44.

4. Claim 53.

As discussed above, the Examiner has failed to identify any features of claim 53 that are taught or suggested by Harrington and Herz, either alone or in combination. Effectively, the Examiner has left it to the Applicant to speculate as to the reason why claim 53 is rejected. Therefore, the Examiner has rejected these claims based on facts within the personal knowledge of the Examiner.

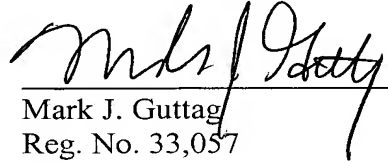
5. Applicants request that the Examiner provide an affidavit under 37 C.F.R. § 1.104(d)(2).

For at least the above reasons, claims 1-13, 15, 18, 26-28, 42-44, 52, and 53 have been rejected on the basis of facts within the personal knowledge of the Examiner. Accordingly, under 37 C.F.R. § 1.104(d)(2), the Applicant hereby requests that the Examiner provide an affidavit that contain the facts supporting each of the Examiner's assertions used as a basis for the rejections of claims 1-13, 15, 18, 26-28, 42-44, 52, and 53.

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Mark J. Guttag at 703-591-2664, Ext. 2006.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,


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